

**PATENT**

Atty. Dkt. No. MRKS/0028.C1

**IN THE DRAWINGS:**

The attached sheet of drawings includes changes to Fig. 1. This sheet, replaces the original sheet. In Figure 1, top drive 110 has been added in the form of a labeled rectangular box. No new matter has been added.

**Attachment: Replacement Sheet**

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## REMARKS

This is intended as a full and complete response to the Final Office Action dated May 6, 2004, having a shortened statutory period for response set to expire on August 6, 2005. Please reconsider the claims pending in the application for reasons discussed below.

### *Drawings*

The drawings stand objected to under 37 C.F.R. § 1.83(a). The Examiner states that the top drive must be shown or the features canceled from the claims. In response, Applicant has amended Figure 1 to show the top drive in the form of a labeled rectangular box identified by reference number 110. The amendment is not new matter since as stated in the originally filed specification "the apparatus 1 is suspended from a top drive (not shown) via connecting shaft 2." Therefore, Applicants respectfully request withdrawal of the objection and acceptance of the drawings.

### *Claim Rejections – 35 U.S.C. § 102*

Claims 13-19 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Willis* (5,036,927). In response, Applicant respectfully traverses the rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Additionally, functional limitations must be evaluated and considered, just like any other limitation of the claim, for what they fairly convey to a person of ordinary skill in the pertinent art in the context in which they are used. *See*, M.P.E.P. §2173.05(g).

Claim 13 recites the limitation that the suspension unit is configured for compensating a tubular engagement tool in order to compensate for movement of an

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upper tubular. However, there is no such suspension unit disclosed in *Willis*. Hydraulic cylinders (reference number 28 in Figure 1) of the top drive drilling assembly in *Willis* move a wrench assembly (reference number 24 in Figures 1 and 2) relative to a load beam (14) in order to selectively actuate a tubular engaging apparatus (30). Specifically, the hydraulic cylinders/load beam that the Examiner refers to as a suspension unit actuates the tubular engaging apparatus to either engage or release a tubular (see, col. 5, lines 41-44; and Figure 2, left side verses right side). Therefore, the suspension unit identified by the Examiner is configured in the assembly disclosed in *Willis* for actuating (*i.e.*, not compensating) the tubular engaging apparatus. Further, actuation of the tubular engaging apparatus fails to compensate for movement of the tubular regardless of whether or not the suspension unit moves the tubular. In other words, the actuation takes place independent of movement of the tubular.

If the suspension unit does move the upper tubular (as specifically required by dependent claims 14-17 contrary to the Examiner's assertion), then, the hydraulic cylinders disclosed in *Willis* cannot meet this limitation. As discussed above, raising the wrench assembly with the hydraulic cylinders causes the tubular engaging apparatus to disengage from the tubular. Absence of an engaged relationship with the tubular prevents the hydraulic cylinders from being able to impart movement to the tubular.

Therefore, the assembly disclosed in *Willis* fails to teach, show or suggest a suspension unit configured for compensating a tubular engagement tool in order to compensate for movement of an upper tubular, as recited in claim 13 and claims dependent thereon. This failure of *Willis* to teach each and every limitation of the claims precludes *Willis* from anticipating the claims. Accordingly, Applicant respectfully requests withdrawal of the rejection and allowance of claims 13-19 and 30.

***Allowable Subject Matter***

Claims 21-29 are allowed. Applicant acknowledges allowance of these claims.

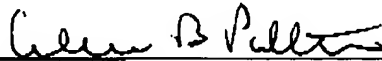
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**Conclusion**

The references cited by the Examiner, alone or in combination, do not teach, show, or suggest the invention as claimed. Having addressed all issues set out in the Final Office Action, Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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